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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,101	02/23/2001	Isabelle Rollat-Corvol	05725.0807	4969

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/719,101	ROLLAT-CORVOL ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *38-106* is/are pending in the application.

4a) Of the above claim(s) *59,61-68,70-77,80-82 and 85-87* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *38-58,60,69,78,79,83,84 and 88-106* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted October 21, 2004 is acknowledged.

Double Patenting Rejections

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38-58, 60, 69, 78,79,83, 84, 88-106 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,346,234 in view of Lee. '234 claims a remodellable hair styling composition comprising at least the tacky polymer herein. See the claims. The claims do not expressly recite the second polymer herein, the fixing polymer.

However, Lee teaches acrylate-based copolymers to be used advantageously as water-soluble amphoteric polymer, such as octlacrylamide/acrylates/butylaminoethyl methacrylate copolymer in hair treating composition (see page 3, lines 30-37). The water soluble amphoteric polymer provides a very substantial hold, and provide aiding in removing the water-insoluble resin in a hair composition from the hair upon shampooing (pages 3, lines 5-14).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ octlacrylamide/acrylates/butylaminoethyl methacrylate copolymer as additional polymer known to be useful in hair treating composition.

A person of ordinary skill in the art would have been motivated to employ octlacrylamide/acrylates/butylaminoethyl methacrylate copolymer as additional polymer known to be useful in hair treating composition because such polymer provide additional benefit to the hair composition.

Claim Rejections 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 38-43, 45-50, 69, 78,79,83, 84, 88-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to composition comprising polymers, which are solely defined by physical properties "tacky" ; Tg, F_{max}, or $Es_{(M/V)}$. etc. However, the specification provides no written description as to what the structural characteristics of a polymer would be required to meet all the functional limitations herein. In view of the fact of lacking working examples, guidance, and direction, one of ordinary skill in the art would have reasonable doubt that applicants, at the time the application was filed, had

actual possession of such polymers other than the particular commercially available polymers herein employed.

Claim Rejections 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 38-58, 60, 69, 78,79,83, 84, 88-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (EP 0551,749, of record), in view of Miller et al. (WO 95/18191, IDS).

Lee teaches a hair treatment composition comprising a water-insoluble, water-dispersible polymeric resin and a water-soluble amphoteric polymer (see abstract, page 3, lines 6-50; and pages 7-8, claims 1-8). Most preferred water-insoluble polymeric resin includes polyesters functionalized with a sulpho group such as Eastman AQ polymers (see pages 3, lines 15-20). Acrylate-based copolymers to be used advantageously as water-soluble amphoteric polymer of the composition, such as octlacrylamide/acrylates/butylaminoethyl methacrylate copolymer in hair treating composition (see page 3, lines 30-37). The water soluble amphoteric polymer provides a very substantial hold, and provide aiding in removing the water-insoluble resin in a hair composition from the hair upon shampooing (pages 3, lines 5-14).

6. Lee does not teach expressly the employment of branched sulfonic polyester herein with Tg less than 20 °C.

7. However, Miller et al. teaches the improved branched sulfonic polyester with lowed Tg. The low Tg provide advantage that the composition will not be brittle at low temperature, thus maintain its property. (see particularly, pages 16-18).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin.

A person of ordinary skill in the art would have been motivated to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin because the branched sulfonic polyester will not become brittle or lost its property at low temperature.

Response to the Arguments

Applicants' remarks submitted October 21, 2004 have been fully considered, but are not persuasive.

Double Patenting Rejection

Applicants assert US Patent 6,346,234 does not claim composition containing "tacky polymer," but fails to point out the difference between the elected "tacky polymers" herein. In fact, the elected tacky polymer is branched sulphonic polymer, the specific example is commercial product polymer AQ 1350 (see pages 9- 10 herein). The "tacky polymers" herein are exactly the same as those "anionic fixative polymer" defined in claim 13 of '234, for which a particular example is commercial product polymer AQ 1350 (see col. 3, lines 29-58 for particular definition and examples for the formula in claim 13).

Applicants further assert "the examiner has pointed to no teaching in the claims of either Rollat or Lee." The assertion is in error. The rejections specifically state "'234 claims a

remodellable hair styling composition comprising at least the tacky polymer herein. See the claims. The claims do not expressly recite the second polymer herein, the fixing polymer." Further, Lee, as secondary reference, is cited to show the level of the art, and therefore is not limited to the claims therein.

Rejections under 35 U.S.C. 112, first paragraph.

Applicants allege that the examiner fails to meet the burden to establish a prima facie case for the rejections. Applicants further contend that pages 4-12 provide reasonable written description about the polymer herein employed. The arguments are not persuasive. Pages 4-6 herein merely provide guidance as to how to determine the functional limitation set forth herein, fail to give any information as to the structure-property relationship, thereby fail to provide a written description for the "tacky polymer" encompassed herein. Particular, there are no written description as to the structural feature of the polymers and method for obtaining the same. Attention is directed to *General Electric Company v. Wabash Appliance Corporation et al* 37 USPQ 466 (US 1938), at 469, speaking to functional language at the point of novelty as herein employed: the vice of a functional claim exists not only when a claims is wholly functional, if that is ever true, but when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty. Functional language at the point of novelty, as herein employed by Applicants, is further admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC 1997) at 1406: stating this usage does little more than outlin[e] goals appellants hope the recited invention achieves and the problems the invention will hopefully ameliorate. Applicants functional language at the point of novelty fails to meet the requirements set forth under 35 USC 112, first or second paragraph.

Claims employing functional language at the point of novelty, such as Applicants, neither provide those elements required to practice the inventions, nor inform the public during the life of the patent of the limits of the monopoly asserted *General Electric Company v. Wabash Appliance Corporation et* supra, at 468. Particularly apropos to the present application is the following statement by the Supreme Court in Brenner v. Manson, 833 O.G. 1349, 148 USPQ 689, 696: "* * * But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion. '[A] patent system must be related to the world of commerce rather than to the realm of philosophy.'" It is apparent that applicants have measured the properties of the commercial product, and try to capture any other polymers with such properties, without knowing the actual chemical structures of those polymers.

Rejections under 35 U.S.C. 103

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, and motivation are found both in the references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Lee at teach hair composition with a combination of polyesters functionalized with a sulpho group such as Eastman AQ polymers (see pages 3, lines 15-20) and acrylate-based copolymers such as octlacrylamide/acrylates/butylaminoethyl methacrylate copolymer, Miller et al. teaches the

improved branched sulfonic polyester with lowed Tg. The low Tg provide advantage that the composition will not be brittle at low temperature, thus maintain its property. As to the particular physical properties of the polymer recited herein, note "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, it is well settled that "As long as some motivation or suggestion to combine the references is provided by the prior art taken as whole, the law does not require that the references be combined for the reason contemplated by the inventor." In re Beattie 947 F.2d 1312 (Fed. Cir. 1992).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

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